

REMARKS

Claims 1-23, 27-32 and 38-45 are pending. Non-elected claims 27-32 and 44-45 were withdrawn from consideration by the Examiner. Their rejoinder is requested upon allowance of the elected claims. Applicant notes that claim 40 is not listed in the Section 112 rejections, but its disposition is incorrectly noted to be “rejected” in the Office Action Summary. Reconsideration and allowance are respectfully requested.

The amendments are fully supported by the original disclosure and, thus, no new matter is added by their entry. They were previously discussed with the Examiner on December 4, 2007 when he proposed amendments that would result in allowance of this application. Therefore, entry of the present amendments will clearly reduce the issues if an appeal were necessary (i.e., appeal would not be required if the amended claims are allowed).

35 U.S.C. 112 – Written Description

The specification must convey with reasonable clarity to persons skilled in the art that applicant was in possession of the claimed invention as of the filing date sought. See *Vas-Cath v. Mahurkar*, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). But the Patent Office has the initial burden of presenting evidence or a reason why persons of ordinary skill in the art would not have recognized such a description of the claimed invention in the original disclosure. See *In re Gosteli*, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989).

Claims 1-23, 38-39 and 41-43 were rejected under Section 112, first paragraph, as allegedly failing to comply with the written description requirement. Applicant traverses because the specification teaches a representative number of species within the claimed genus.

The claims are directed to polypeptides having at least β -glycosidase activity. This recitation, along with corrective amendments to clarify the nature of the mutations in the polypeptide as compared to the amino acid sequence of SEQ ID NO:2, complies with the written description requirement because such modified polypeptides were in the possession of Applicant when this application was filed.

Withdrawal of the written description rejection is requested.

35 U.S.C. 112 – Enablement

The Patent Office has the initial burden to question the enablement provided for the claimed invention. M.P.E.P. § 2164.04, and the cases cited therein. It is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. *In re Marzocchi*, 169 USPQ 367, 370 (C.C.P.A. 1971).

Claims 1-23, 38-39 and 41-43 were rejected under Section 112, first paragraph, as allegedly failing to comply with the enablement requirement. Applicant traverses because the specification enables the skilled artisan to practice the claimed invention.

The claims are directed to polypeptides having at least β -glycosidase activity. This recitation, along with corrective amendments to clarify the nature of the mutations in the polypeptide as compared to the amino acid sequence of SEQ ID NO:2, complies with the enablement requirement because it would not require undue experimentation to make and use such modified polypeptides.

Withdrawal of the enablement rejection is requested.

Conclusion

Having fully responded to the pending Office Action, Applicant submits that the claims are in condition for allowance and earnestly solicit an early Notice to that effect. The Examiner is invited to contact the undersigned if any further information is required.

Respectfully submitted,

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